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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/376,794	08/18/99	KROPKE	R BEIERSDORF-5

EXAMINER

HM22/1017

KISHORE, G

SPRUNG KRAMER SHAEFER & BRISCOE
660 WHITE PLAINS ROAD
TARRYTOWN NY 10591-5144

ART UNIT	PAPER NUMBER
1615	6

DATE MAILED: 10/17/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 8-9-00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 4-11 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 4-11 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

★ U.S. GPO: 1996-421-632/402

DETAILED ACTION

The request for the extension of time and amendment filed on 8-9-00 are acknowledged.

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

2. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what 'tackiness' in claim 4 intend to convey. There is no specific definition of this term in the specification and as to how much it is decreased. Since it is unclear what it means and how much it is reduced, the term 'effective amount' is deemed to be indefinite.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 771 566 or Magdassi (US 5,518,736) or FR 2667 072.

FR disclose compositions containing chitosan and phospholipid (note the abstract, Examples on page 11).

Applicant's arguments have been fully considered, but are not found to be persuasive. The differences argued cannot be determined since applicant has not provided an English translation. The reference appears to teach the stability of the composition by chitosan.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 771 566 or Magdassi cited above by themselves or in combination.

EP, Magdassi and FR disclose compositions containing chitosan and phospholipid (note the abstract, Tables and claims of EP columns 5 and 8 and claims of Magdassi; note Examples on page 11).

EP does not explicitly state the molecular weight and the degree of deacylation. Assuming they are different, the reference clearly teaches that these polysaccharides stabilize the emulsions and that chitosans with different molecular weights and degree Of deacylation are readily available in the market (page 2). Therefore, it would have been obvious to one of ordinary skill in the art to use any of the commercially available chitosans with a reasonable expectation of obtaining similar stability.

Similarly Magdassi does not specifically teach the molecular weight and the degree of deacylation. As pointed out above, it is deemed obvious to one of ordinary skill in the art to use a specific chitosan in the teachings of Magdassi with the expectation of obtaining similar results. An artisan would be motivated to use any chitosan since EP shows that these are readily available in the market.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant argues that the present claims are drawn to a method of reducing the tackiness or method of increasing the stability and the references do not teach these. With regard to tackiness, there is no specific definition of this term in the specification and applicant himself has not shown that the tackiness is reduced. The dictionary meaning of tackiness is 'sticky' and applicant has not shown that the prior art compositions are sticky.

With regard to the stability, the examiner points out that both references teach the increase in the stability of the compositions.

7. Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2 667 072 cited above by itself or in combination with EP cited above.

It is unclear whether FR teaches instant molecular weights or degree of deacylation. As pointed out above, it is deemed obvious to one of ordinary skill in the art to use a specific chitosan in the teachings of FR. with the expectation of obtaining similar results. An artisan would be motivated to use any chitosan since EP shows that these are readily available in the market.

Applicant's arguments have been fully considered, but are not found to be persuasive. Applicant's arguments are similar to those for the above rejection and therefore, the same reasoning applies.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1235.

Gollamudi S. Kishore, Ph. D

Primary Examiner

Group 1600

gsk

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